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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,745	08/12/2002	James R. Birle JR.	MLCO.P002	6610
57380	7590	09/07/2006	EXAMINER	
OPPEDAHL & OLSON LLP P.O. BOX 4850 FRISCO, CO 80443-4850			APPLE, KIRSTEN SACHWITZ	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/064,745

Applicant(s)

BIRLE ET AL.

Examiner

Kirsten S. Apple

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/8/06</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

***Double Patenting***

In view of the applicants comments the examiner will withhold double patenting rejection until pending claims have been granted.

***Claim Rejections - 35 USC § 112***

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 1-95 under 35 USC 112.

According to a definition of promise it is:

**“promise** - something that has the effect of an express assurance; indication of what may be expected.”

However, as described in the examples from the applicant a promise is “a person signing a credit card slip” and they “promise” to pay the merchant. Using this example a merchant would want more assurance than they “may” be paid. If this example were the intension of the applicant and for clarity the examiner would propose using “contractually agrees” or the like. The examiner will interpret it as such.

Additionally, everything in claim 1 after “promising” is interpreted by the examiner as intended use only in it's current form. The promising step has no relationship to the converting step. As the claim current reads it is interpreted to only include:

“issuing the financial instrument

converting the instrument upon request”

All other language is interpreted as intended use only in this current form. The examiner believes that the applicant intends to have the additional feature or would not have included them in the claim language and suggests rewording the claim as to positively recite them in the claim. Such as

"converting based on the contractual agreement...."

In it's current form it is incomplete and unclear.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Additional, the term "converting" does not specify, "what it is being converted into"

Appropriate action is required.

***Claim Rejections - 35 USC § 101***

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 10-25 & 35-43 & 52-59 & 62-75 & 84-90 & 92 & 95 under 35 USC 101.

The Examiner redraws the attention in particular to at least the independent claims recite a "financial instrument" or an "offering document."

The examiner would like to provide further explanation by explaining that the claims are rejected under 35 USC § 101 because the claimed inventions are directed to non-statutory subject matter. The claims are directed to disembodied data structure which are per se are not statutory (*In re Warmerdam*, No. 93-1294 (Fed. Cir. August 11, 1994)).

Note that functional descriptive material consists of data structure and computer programs which impart functionality when employed as a computer component.

Nonfunctional descriptive material includes but is not limited to music, literary works and a compilation or mere arrangement of data.

In the present case, the claimed data structure is mere arrangement of data without any associated functionality. The applicant argues that data structures are “to store data” that defines an organizational model. However, the intended use of the data structure does not impart functionality to the data structure where the data structure is mere arrangement of data. The data structures merely store data which are non functional since without any association with programmed code executable by a processor their functionality cannot be realized.

Quoting MPEP section 2106. IV. B. 1.

“When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk.”

The applicant's argument that the data structure of the computer readable medium "stores data that defines organizational model that controls a network-based budget planning system for reconciliation of target data and forecast data for an organization" is not persuasive because the data structures themselves are passive and cannot perform any function. Only when the Data structures are used or accessed in conjunction with programmed computer instructions codes to realize the underlying functionality. In the instant case, the data structure is mere arrangement of storing data pertaining to an organizational model which is intended to perform the aforementioned functionality, however, the functionality itself as asserted by the applicant is not positively recited.

While the above example from the MPEP is direct to data and computer structure the same principals hold true for "financial instrument" or an "offering document."

Corrective action to Claims 10-25 & 35-43 & 52-59 & 62-75 & 84-90 & 92 & 95 are required.

### ***Claim Rejections - 35 USC § 103***

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner withdraws the rejection of claims 1-93 under 35 USC 103.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

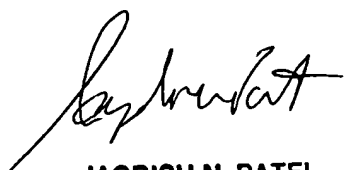
***Contact Details***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KSA



**JAGDISH N. PATEL**  
**PRIMARY EXAMINER**